

REMARKS

Claims 1-10 appear in this application for the Examiner's review and consideration.

Claim 1 has been amended to recite that the titanium mesh vibration material is integrally juxtaposed with the crown portion of the club head. Support for the amended element is found at least in the Specification, on page 17, lines 16-19, and on FIGS. 12a and 12b, which shows this shock absorption layer (66) to be juxtaposed against the crown without any gap whatsoever.

. Claims 11-28 have been cancelled without prejudice to Applicants' right to file one or more continuing applications directed to any subject matter not presently claimed.

No new matter has been added by this amendment.

Rejection Over Yabu

Claims 1-10 were rejected under 35 U.S.C. § 103(a) as being obvious over Yabu (U.S. Patent No. 6,932,719)

The Applicants' must respectfully disagree with the Examiner's interpretation of the inner plate (23) of Yabu ('719) being even remotely equivalent of their shock absorption layer (66). It must be appreciated that the Applicants inventive aspect is to provide a vibration dampening material juxtaposed against the inside surface of the crown as shown in FIGS. 12a and 12b, that will absorb noise and shock. Yabu does not address these aims. Actually, Yabu teaches away from these concepts since he does not seek to absorb shock as much as to provide rigidity, or stiffness, to the crown (col.2, lines 14-47). Yabu does not discuss shock absorption, nor is his inner plate (23) juxtaposed against the inside surface of the crown, but rather Yabu teaches a substantial gap between his outer plate (21) and inner plate (23), which is created by the inner plate (23) having projections (25) that prevent the inner plate (23) from juxtaposing against the crown (upper plate). While the gap therein created by the projections may be filled, it defeats the Applicants' purpose of providing only an inner layer for shock absorption and not the necessity of a third layer of filling.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The teachings of Yabu ('719) at no time discuss the reduction in noise or teach the desire for shock absorption. The Applicants clearly teach providing an integral layer juxtaposed against the inner surface of the crown portion to provide them. There is no gap between the Applicants' layers, as there is in Yabu ('719)

It is well held that a *prima facie* case of obviousness can be rebutted if Applicant can show that the cited reference, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 43 U.S.P.Q.2d 1362, 1365 (Fed. Cir. 1997). The reference may further be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be led in a direction divergent from the path that was taken by Applicant. *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 U.S.P.Q.2d 1294, 1298 (Fed. Cir. 1999).

The Yabu ('719) basically teaches the opposite of the Applicants' inventive concept. Yabu's inventive concept is to stiffen, or make more rigid, his outer plate (21) which is the crown of the club head, and certainly a reason man skilled in the art could interpret this as the opposite of providing a dampening effect to the crown.

The rejection under 35 U.S.C. § 103(a) is believed to have been overcome for at least the above reasons. Applicants respectfully request reconsideration and withdrawal thereof.

Rejection Over Lu

Claim 11 was rejected under 35 U.S.C. § 103(a) as being obvious over Lu (U.S. Publication 2004/0224790). Claim 28 was cancelled mooted this rejection.

Conclusion

Based on the remarks set forth above, Applicants believe that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' agent would further the prosecution of this application, the Examiner is encouraged to call the agent at the number below.

No fee is believed to be due for this submission. However, should any required fees be due, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,

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Date

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